

REMARKS

Originally presented claims 1-15 have been canceled and new claims 16-28 are presented. New compound claims 16-23 correspond to originally filed pharmaceutical composition claims 1-8; and new claims 24-28 correspond to originally filed claims 11-15. New pharmaceutical composition claims 29 and 30 are intended to be identical in scope to originally filed claims 1 and 12.

Specifically, claim 16 has been amended to be directed to the compounds *per se* (instead of pharmaceutical compositions comprising them) and to better detail the various possibilities for rings A, B, C, and D of the claimed compounds. Only formula (I) is now presented, which has been altered to denote the inherent delocalization of electrons around the macrocyclic ring (indicated by the dotted line) with the exception of the A, B and D rings because they are reduced to form the claimed chlorins, isobacteriochlorins, and bacteriochlorins.

Because of the electron delocalization, the various tautomeric forms for rings A, B, C and D are set forth in two sets (denoted by "i)" and "ii)" in claim 16) with the first corresponding to one tautomeric form of the first possibility for ring A in claim 1 as originally filed and the second corresponding to a second tautomeric form of all three possibilities for ring A in claim 1 as originally filed.

A simple comparison of the first and second sets of ring possibilities shows that they are directed to two sets of tautomeric forms that may be drawn for the claimed chlorins, isobacteriochlorins, and bacteriochlorins.

No new matter has been introduced and entry of the amended claims is respectfully requested.

Attached hereto is a version of new claims 16-28 as presented by the instant amendment. The attached pages begin with the caption **“Version with markings to show changes made.”**

Applicant has carefully reviewed the Restriction Requirement mailed July 26, 2001 and request reconsideration in light of the above amendments and following discussion.

The Examiner has stated that the compounds of formula (I) and (II) as presented in claim 1 as originally filed are classified in different subclasses and are properly Restricted in part on this basis. This is respectfully traversed because a review of the Manual of Classification and the Class definitions indicates that compounds of formulas (I) and (II) as originally presented are properly classified in class 514/185 (which is indented from both subclasses 183 and 184). It would be improper to classify formula (II) compounds at subclass 183 as indicated in the Restriction Requirement because they are encompassed by the definition for subclass 185.

Moreover, and as evident from a review of formulas (I) and (II), they differ only in that the “M” moiety of formula (I) is replaced by two hydrogen atoms in formula (II). Applicants respectfully submit that this presents *no serious burden of search* as required to support Restriction between claims. Applicants also point out that new claim 16 continues to encompass both the metals of previous formula (I) and the two hydrogen atoms of formula (II) via the scope of “M” as recited in claim 16.

Applicants also traverse the Restriction Requirement because of U.S. Patents 5,648,485 (provided with the IDS filed October 12, 2001, hereafter the ‘485 patent) and 5,831,088 (copies of the first page and claims provided herewith, hereafter the ‘088 patent). The ‘088 patent issued from a divisional application of application 08/329,577, which issued as the ‘485 patent. A

review of the claims in (and file histories of) both patents shows that claims directed to compounds with formulas (I) and (II) as originally presented in claim 1 were not restricted apart.

Instead, a restriction was made between the compounds *per se* (the '485 patent) and the methods for their preparation (the '088 patent). The '485 patent therefore provides support for the **lack of a *serious burden of search*** in keeping compounds of formulas (I) and (II) together.

Based on the above, Applicants hereby respectfully urge that the instant Restriction Requirement be withdrawn. In the event that a modification to the Restriction Requirement is made, the undersigned requests that he be contacted to make an telephonic election.

In the event that the Restriction is maintained, Applicants hereby elect compounds with "M" as a metal instead of two hydrogen atoms, with traverse.

Applicant requests examination of the elected subject matter on the merits.

Conclusion

In light of the above discussion and new claims, Applicants respectfully request that new claims 16-30 be examined. In the event the Examiner finds that a telephonic discussion may be helpful to address any residual Restriction issues, she is respectfully invited to contact the undersigned.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this

document to **Deposit Account No. 03-1952** referencing 273012011200. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: August 27, 2001

Respectfully submitted,

By: 
Kawai Lau
Registration No. (44,461)

Morrison & Foerster LLP
3811 Valley Centre Drive
Suite 500
San Diego, California 92130-2332
Telephone: (858) 720-5178
Facsimile: (858) 720-5125